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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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MOTOROLA INC
600 NORTH US HIGHWAY 45
ROOM AS437
LIBERTYVILLE, IL 60048-5343

EXAMINER

CHOUDHURY, AZIZUL Q

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 08/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,790

Applicant(s)

COUTS ET AL.

Examiner

Azizul Choudhury

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/01, 3/03</u> | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

This office action is in response to the correspondence received on May 19, 2005.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-10, 12, 14-15, and 17-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Wickam et al (US Pub No: US 2002/0078151A1), hereafter referred to as Wickam.

1. With regards to claim 1, Wickam teaches a method for a data network system for forwarding a communication message intended for a target device to another device, the method comprising the steps of: receiving a communication message from an originating device; retrieving configuration information of the target device, the configuration information including a forwarding list identifying at least one next device; determining whether the target device is available for text messaging with the originating device based on the configuration data; routing the communication message to the target device if the target device is available

for text messaging with the originating device; and forwarding the communication message to a particular next device of the at least one next device if the target device is unavailable for text messaging with the originating device (Wickam teaches a communication design with call forwarding means (paragraph 45, Wickam). The design allows a user to set preferences regarding how to transfer calls while they are away from the phone. This preference list (call forwarding list) is retrieved by the system when a caller is trying to reach the user. When a call is made, the call is transferable in multiple ways. One method is to forward calls sequentially to various devices if the call is not picked up. Another method is to forward calls to devices pre-selected by the user with the user knowing that they will be away. If the call is not picked up (the device is unavailable), the call is forwarded to a voice mailbox. One of the pre-selected which the call can be forwarded to is a PDA hence, "text messaging" is enabled by the Wickam design).

2. With regards to claim 2, Wickam teaches the method further comprising the step of configuring the configuration data of the target device before the step of receiving the communication message from the originating device (Wickam's design allows a user to set their call forwarding preferences. Such preferences inherently must be configured before the step of receiving the communication message from the originating device as claimed (paragraph 45, Wickam)).

3. With regards to claim 3, Wickam teaches the method further comprising the step of retrieving status information of at least one of the originating device and the target device, wherein the step of determining whether the target device is available for text messaging includes the step of comparing the status information against the configuration data to determine whether the target device is available for text messaging (Wickam's design has the user set their preferences and allows users to pre-select the device by which to contact them when they are away (paragraph 45, Wickam). The design allows users to set up either "find me" or "follow me" options hence, user status information is available and is accessible by the system. Plus, one of the pre-selected, which the call can be forwarded to, is a PDA hence, "text messaging" is enabled by the Wickam design).
4. With regards to claim 4, Wickam teaches the method wherein the status information includes a location of the target device (Wickam's design has the user set their preferences and allows users to pre-select the devices by which to contact them when they are away (paragraph 45, Wickam). Inherently the location of the devices must also be known by the system since the call is forwarded to those devices. The design allows users to set up either "find me" or "follow me" options hence, user status information is available and is accessible by the system).

5. With regards to claim 5, Wickam teaches the method further comprising the step of determining whether the originating device is present on, the forwarding list (Wickam's design features a list pre-selected by the user of devices to which calls are to be forwarded to. The system has access the information about those devices and hence means are present by which to check the number of the originating device on the forwarding list as claimed).
6. With regards to claim 6, Wickam teaches the method further comprising the step of identifying the particular next device as having a highest priority among the at least one next device of the forwarding list (Wickam teaches a communication design with call forwarding means (paragraph 45, Wickam). The design allows a user to set preferences regarding how to transfer calls while they are away from the phone. When a call is made, the call is transferable in multiple ways. One method is to forward calls sequentially to various devices if the call is not picked up. Another method is to forward calls to devices pre-selected by the user with the user knowing that they will be away. If the call is not picked up (the device is unavailable), the call is forwarded to a voice mail box. Since a call list is available and means are present to sequentially go through the list, the claimed priority means are present within Wickam's design).
7. With regards to claim 7, Wickam teaches the method further comprising the steps of: determining that the particular next device is not available to receive the

communication message; and selecting another next device of the at least one next device (Wickam teaches a communication design with call forwarding means (paragraph 45, Wickam). The design allows a user to set preferences regarding how to transfer calls while they are away from the phone. When a call is made, the call is transferable in multiple ways. One method is to forward calls sequentially to various devices if the call is not picked up. Another method is to forward calls to devices pre-selected by the user with the user knowing that they will be away. If the call is not picked up (the device is unavailable), the call is forwarded to a voice mail box).

8. With regards to claim 8, Wickam teaches the method further comprising the step of forwarding the communication message to the another next device, instead of the particular next device, if the another next device is available for text communication with the originating device (Wickam teaches a communication design with call forwarding means (paragraph 45, Wickam). The design allows a user to set preferences regarding how to transfer calls while they are away from the phone. When a call is made, the call is transferable in multiple ways. One method such method is to forward the call to the device most recently used by the user, hence allowing for another next device to be selected to receive the call for the user. Plus, one of the pre-selected, which the call can be forwarded to, is a PDA hence; "text messaging" is enabled by the Wickam design).

9. With regards to claim 9, Wickam teaches the method wherein the forwarding list identifies next devices in order of priority as pre-configured for the target device (Wickam teaches a communication design with call forwarding means (paragraph 45, Wickam). The design allows a user to set preferences regarding how to transfer calls while they are away from the phone. When a call is made, the call is transferable in multiple ways. One method is to forward calls sequentially to various devices if the call is not picked up. Since the devices are tried sequentially, means for priority exist. Another method is to forward calls to devices pre-selected by the user with the user knowing that they will be away. If the call is not picked up (the device is unavailable), the call is forwarded to a voice mail box. Since a call list is available and means are present to sequentially go through the list, the claimed priority means are present within Wickam's design).

10. With regards to claim 10, Wickam teaches the method wherein the forwarding list identifies next devices in order of priority based on a proximity of the next devices relative to one of either the originating device and the target device (Wickam teaches a communication design with call forwarding means (paragraph 45, Wickam). The design allows a user to set preferences regarding how to transfer calls while they are away from the phone. When a call is made, the call is transferable in multiple ways. One such method is to forward the call to the

device most recently used by the user, hence allowing proximity based device selection).

11. With regards to claim 12, Wickam teaches the method further comprising the step of receiving authorization from the originating device before forwarding the communication message to the particular next device (Wickam's design allows the caller to go through an IVR, providing the caller the option to forward the call/message to the user or not to (paragraph 46, Wickam)).

12. With regards to claim 14, Wickam teaches the method further comprising the step of receiving authorization from the particular next device before the target device adds the particular next device to the forwarding list (Wickam's design allows for the forward list to be edited. The design allows for a setup so that calls are forwarded to devices with the user's name (paragraph 45, Wickam). This is one such authorization means by which to limit adding devices).

13. With regards to claim 15, Wickam teaches the method further comprising the step of modifying the communication message before forwarding the communication message to the particular next device (Wickam's design allows for messages to be converted before being forwarded (paragraph 33, Wickam)).

14. With regards to claim 17, Wickam teaches a data network system for forwarding a select message communicated by a mobile station to at least one other mobile station, the data network system comprising: a messaging server for communicating with a plurality of devices, the messaging server being capable of routing a communication message from an originating device to a target device; and a messaging proxy coupled to the messaging server, the messaging proxy having access to a database that includes a forwarding list of the target device that identifies at least one next device, the messaging proxy being effective to determine whether the target device is available for text messaging with the originating device, route the communication message to the target device if the target device is available for text messaging with the originating device, and forward the communication message to a particular next device of the at least one next device if the target device is unavailable for text messaging with the originating device (Wickam teaches a communication design with call forwarding means (paragraph 45, Wickam). The design allows a user to set preferences regarding how to transfer calls while they are away from the phone. This preference list (call forwarding list) is retrieved by the system when a caller is trying to reach the user. When a call is made, the call is transferable in multiple ways. One method is to forward calls sequentially to various devices if the call is not picked up. Another method is to forward calls to devices pre-selected by the user with the user knowing that they will be away. If the call is not picked up (the device is unavailable), the call is forwarded to a voice mailbox. One of the pre-

selected which the call can be forwarded to is a PDA hence; "text messaging" is enabled by the Wickam design).

15. With regards to claim 18, Wickam teaches the data network system wherein the messaging proxy is incorporated within the messaging server (The system of Wickam's design allows the system to be comprised within a single entity or multiple entities (Figures 4 and 5, Wickam). Furthermore, Wickam states that reasonable variations are acceptable in the design while still having the spirit of the design intact. Having devices incorporated together or separated apart is such a reasonable variation since it has no impact on the functionality of the design).

16. With regards to claim 19, Wickam teaches the method wherein the database is stored in the messaging server (Wickam's design allows the database to be stored within the system (Figure 4, Wickam). Furthermore, Wickam states that reasonable variations are acceptable in the design while still having the spirit of the design intact. Having devices incorporated together or separated apart is such a reasonable variation since it has no impact on the functionality of the design).

17. With regards to claim 20, Wickam teaches the method wherein the database is stored in the messaging proxy (The system of Wickam's design allows the

system to be comprised within a single entity or multiple entities (Figures 4 and 5, Wickam). Furthermore, Wickam states that reasonable variations are acceptable in the design while still having the spirit of the design intact. Having devices incorporated together or separated apart is such a reasonable variation since it has no impact on the functionality of the design).

18. With regards to claim 21, Wickam teaches the data network system wherein the messaging proxy determines that the originating device allows forwarding of messages (Wickam's design allows the caller to go through an IVR, providing the caller the option to forward the call/message to the user or not to (paragraph 46, Wickam)).

19. With regards to claim 22, Wickam teaches the data network system wherein the messaging proxy selects a next user from the forwarding list until an available next user is found (Wickam teaches a communication design with call forwarding means (paragraph 45, Wickam). The design allows a user to set preferences regarding how to transfer calls while they are away from the phone. When a call is made, the call is transferable in multiple ways. One method is to forward calls sequentially to various devices if the call is not picked up. Another method is to forward calls to devices pre-selected by the user with the user knowing that they will be away. If the call is not picked up (the device is unavailable), the call is forwarded to a voice mail box).

20. With regards to claim 23, Wickam teaches the data network system wherein the forwarding list identifies next devices in order of priority as pre-configured for the target device (Wickam teaches a communication design with call forwarding means (paragraph 45, Wickam). The design allows a user to set preferences regarding how to transfer calls while they are away from the phone. When a call is made, the call is transferable in multiple ways. One method is to forward calls sequentially to various devices if the call is not picked up. Another method is to forward calls to devices pre-selected by the user with the user knowing that they will be away. If the call is not picked up (the device is unavailable), the call is forwarded to a voice mail box. Since a call list is available and means are present to sequentially go through the list, the claimed priority means are present within Wickam's design).

21. With regards to claim 24, Wickam teaches the data network system wherein the forwarding list identifies next devices in order of priority based on a proximity of the next devices relative to one of either the originating device and the target device (Wickam teaches a communication design with call forwarding means (paragraph 45, Wickam). The design allows a user to set preferences regarding how to transfer calls while they are away from the phone. When a call is made, the call is transferable in multiple ways. One method is to forward calls sequentially to various devices if the call is not picked up. Another method is to

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forward calls to devices pre-selected by the user with the user knowing that they will be away. If the call is not picked up (the device is unavailable), the call is forwarded to a voice mailbox. Since a call list is available and means are present to sequentially go through the list, the claimed priority means are present within Wickam's design. In addition, another forwarding method is to forward the call to the device most recently used by the user, hence allowing proximity based device selection).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wickam et al (US Pub No: US 2002/0078151A1) in view of Adams et al (US Pat No: US006631186B1), hereafter referred to as Wickam and Adams, respectively.

22. With regards to claim 11, Wickam teaches through Adams, the method further comprising the step of configuring the messaging proxy to prohibit forwarding of messages, received from the originating device, to other devices

(Wickam's design allows for a user to select preferences to a call forwarding list (paragraph 45, Wickam). However, Wickam's design does not disclose the feature of prohibiting the forwarding of messages.

Adams teaches a design for a call forwarding system. The design allows calls to be rejected based on numbers (column 32, lines 58-62, Adams).

Both Wickam and Adams teach design for forwarding messages. Hence, it would have been obvious, to one skilled in the art, during the time of the invention, to have combined the teachings of Wickam with those of Adams, to provide for a method of implementing a call forwarding service (column 7, lines 10-11, Adams)).

23. With regards to claim 13, Wickam teaches through Adams, the method further comprising the step of identifying a mark in the communication message indicating that the communication message may not be forwarded to other devices

(Wickam's design allows for a user to select preferences to a call forwarding list (paragraph 45, Wickam). However, Wickam's design does not disclose the feature of prohibiting the forwarding of messages.

Adams teaches a design for a call forwarding system. The design allows calls to be rejected based on numbers (column 32, lines 58-62, Adams). Since calls to be blocked are detectable, a mark(s) of some form inherently must be present on the call (message) to block it.

Both Wickam and Adams teach design for forwarding messages. Hence, it would have been obvious, to one skilled in the art, during the time of the invention, to have combined the teachings of Wickam with those of Adams, to provide for a method of implementing a call forwarding service (column 7, lines 10-11, Adams)).

24. With regards to claim 16, Wickam teaches through Adams, the method wherein the communication message is modified to prevent the communication message from divulging an identity of the originating device to the particular next device (Wickam's design allows for a user to select preferences to a call forwarding list (paragraph 45, Wickam). However, Wickam's design does not disclose the feature of prohibiting the forwarding of messages.

Adams teaches a design for a call forwarding system. The design allows calls to be rejected based on numbers (column 32, lines 58-62, Adams). The design uses an "Anonymous Call Rejection," (column 32, lines 58-59, Adams). Hence, means by which to prevent divulging a message's identity are present.

Both Wickam and Adams teach design for forwarding messages. Hence, it would have been obvious, to one skilled in the art, during the time of the invention, to have combined the teachings of Wickam with those of Adams, to provide for a method of implementing a call forwarding service (column 7, lines 10-11, Adams)).

Remarks

The office action received on May 19, 2005 has been carefully evaluated but is not deemed fully persuasive. The applicant's representative has amended the claim language to replace "interactive communication" with "text messaging." The remarks point to these amendments and suggest that such traits are not supported with the Wickam design. After reviewing the claimed invention along with the Wickam disclosure, the examiner has determined that the Wickam prior art does in fact encompass the claimed trait of "text messaging." The Wickam disclosure teaches within paragraph 45 that the calls can be forwarded to a device pre-selected by the user. One such device is a PDA. If a PDA can accept network data, such as the one in Wickam's design, it is well known in the art that the PDA can handle text messaging. For these reasons, the examiner must stand by his rejections.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action:

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Azizul Choudhury whose telephone number is (571) 272-3909. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (571) 272-6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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